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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,301	05/04/2001	Minoru Matsushita	P20596	9618

7055 7590 11/12/2002

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EXAMINER

RAM, JOCELYN DEBRA

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 11/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

elasticity  $\frac{XXX}{1111} m$  laminate  
 $\frac{8000}{8000} core$

138/140  
149  
137  
124

**Office Action Summary**

Application No.

09/848,301

Applicant(s)

MATSUSHITA ET AL.

Examiner

Jocelyn D Ram

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 22-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of Species I in Paper No. 7 is acknowledged. The traversal is on the grounds that the search would not be a "serious burden" to the examiner. This is not found persuasive because the MPEP does not require that there be a "serious burden" placed on the examiner in order to restrict between different embodiments, since the number of embodiments inherently presents a burden. The requirement is still deemed proper and is therefore made FINAL.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6 and 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of copending

Application No. 09/942720. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 6 and 7 of the instant application are merely broader than claim 10. Claim 10 recites all of the limitations of the instant application in addition to limiting the melting points of the coating layer and the outer cover. Claim 10 represents a species of claims 6 and 7. Since the more specific anticipates the broader invention, claims 6 and 7 are unpatentable over claim 10.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Specification*

The disclosure is objected to because of the following informalities: page 1, line 20, "bucking" should be changed to -buckling--; and page 2, line 10, "word" should be changed to -words--.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "chemical" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 13 and 14 state "any of the inner and intermediate layers". It is unclear if this is referring to either of the layers, or both of the layers.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-5 and 8-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Sugiyama et al. (6,458,075). Sugiyama shows a flexible tube for an endoscope comprising: an elongated tubular core body including a spiral tube (10) and a reticulate tube (20) which inherently has recesses (21); and an outer cover (30) which is provided over the core body, the outer cover having a portion which is formed into a laminate structure composed of at least 3 layers (30A, 30B, 30C); wherein the layers are made of

elastomers molded by extrusion; the inner layer (30A) has projections (31) that project into the recesses of the reticulate tube (col 3, lines 31-34); the outer layer (30B) is harder than the inner layer and the intermediate layer and has a high chemical resistance (col 3, lines 51-53); the flexibility increases from the base to the tip of the flexible tube (col 4, lines 57-60); the intermediate layer (30C) has a higher elasticity than the outer layer and inherently acts as a cushioning means.

Claims 1-4, 8-10, 16, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Katsurada et al. (5,217,002). Katsurada shows a flexible tube for an endoscope comprising: an elongated tubular core body including a coil (11) and a reticulate tube (12) which inherently has recesses; and an outer cover (elastomer 15, resin tube 16, metallic braid tube 17) which is provided over the core body, the outer cover having a portion which is formed into a laminate structure composed of at least 3 layers.

Claims 1-4, 8-11, 16-18, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Morishita (4,753,222). Morishita shows a flexible tube for an endoscope comprising: an elongated tubular core body including a spiral tube (14) and a reticulate tube (braid 16) which inherently has recesses; and an outer cover (sheath 18) which is provided over the core body, the outer cover having a portion which is formed into a laminate structure composed of at least 3 layers (22, 30, 32); wherein the layers are

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formed of elastomers (col 4, lines 17-32) having a resistance to chemicals (polyolefin is known to have high chemical resistance to disinfectants, see US 6,458,075) and can be molded by extrusion (col 4, line 16) and the flexibility of the tube increases from the base to the tip end (col 4, lines 52-53).

Claims 1-4, 8 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Strong (6,083,152). Strong shows a flexible tube for an endoscope comprising: an elongated tubular core body including a spiral tube (14) and a reticulate tube (braid 18) which inherently has recesses; and an outer cover (94, 98, 100) which is provided over the core body, the outer cover having a portion which is formed into a laminate structure composed of at least 3 layers; wherein the layers can be molded by extrusion.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morishita in view of Iwasaka (5,885,207). Morishita shows all of the limitations of claims 6 and 7 except for one of the wires of the reticular tube having a compatible

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material coating that is bonded to the inner layer of the outer cover. Iwasaka shows a flexible tube for an endoscope comprising: an elongated tubular core body including a spiral tube (11) and a reticulate tube (20) wherein at least one of the wires (21a) forming the reticular tube (20) is coated with a synthetic resin (21b) to bond to the outer cover (resin sheath 30). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a synthetic resin coating on at least one of the wires of the reticulate tube of Morishita in order to prevent the outer cover from separating from the reticulate tube during bending, as taught by Iwasaka (col 3, lines 1-6).

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ouchi et al. (4,899,787; 4,690,175), Ohara et al. (6,206,824), Boury (5,916,147), Wu et al. (5,876,331), Watanabe (5,448,988), Samson et al. (6,197,014), Ouchi (6,402,687), Katsurada et al. (5,217,002) all show flexible tubes for an endoscope which include a spiral coil, a reticulate tube, and an outer layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn D Ram whose telephone number is (703) 308-6392. The examiner can normally be reached on Mon-Fri, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone numbers

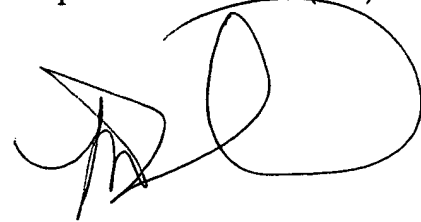


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for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to be "LD", enclosed within a large, hand-drawn oval.

JR  
November 7, 2002

LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700